

REMARKS:

In accordance with the foregoing, new claim 90 has been added. Claims 73-89 were not been considered in the Office Action mailed February 3, 2004. No new matter has been added, thus, claims 1, 2, 4-7, 9-15, 33-38, and 43-90 are pending and under consideration.

INFORMATION DISCLOSURE STATEMENT:

On page 2 of the outstanding Office Action, the Examiner stated that the IDS filed on April 19, 2001 fails to comply with 37 C.F.R. §1.98(a)(2). Pursuant to the Examiner's telephone request of February 13, 2004, a copy of the IDS filed was resubmitted on February 20, 2004.

Accordingly, it is requested that the Examiner acknowledge the IDS submitted on April 19, 2001.

DOUBLE PATENTING REJECTION:

In the outstanding Office Action, the Examiner rejected claims 1 and 2 of the present application as being unpatentable over U.S. Patent 6,256,640 under a Double Patenting rejection.

Accordingly, a Terminal Disclaimer to obviate a Double Patenting rejection under 37 C.F.R. §1.321(b) is submitted herewith.

CLAIMS NOT CONSIDERED BY THE EXAMINER:

The Examiner has not considered claims 73-89 in the outstanding Office Action. A Supplementary Preliminary Amendment adding Claims 73-89 was filed on May 6, 2003. The Patent Application Information Retrieval (PAIR) provided by the U.S. Patent and Trademark Office shows that a "Response after Non-Final Action" was filed on May 6, 2003; however, the Supplemental Preliminary Amendment filed on May 6, 2003 seems to have been made of record after the mailing made of the outstanding Office Action. For the convenience of the Examiner, a copy of the May 6, 2003 filing is submitted herewith.

For the foregoing reasons, Applicants request that the Examiner consider claims 73-89.

REJECTION UNDER 35 U.S.C. §102(e):

In the outstanding Office Action, claims 1, 2, 4-7, 9-15, and 23-72 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,664,112 ('112). The rejection is traversed and reconsideration is respectfully requested.

'112 discusses an integrated approach for all management activities in relation to hazardous substances used or generated at a *facility* by utilizing six functional groupings and a relational database design.

The present application discloses a system to be used by regulatory agencies to manage regulated entities using a database system architecture having integrated data management.

The Examiner compares the '112 system for management of hazardous substances at a regulated facility with the system of the present invention for managing information of multiple regulated entities by a regulatory agency. All substance information managed by the '112 system is organized according to the regulated facility and location parameters defined by a user (see, column 11, lines 52-54 of '112). Materials arriving at a receiving dock of the regulated facility may be tracked from receipt through temporary storage to distribution and final destination (see, column 12, lines 2-6 of '112), and functional groupings of the '112 system allow users to define and quantify all releases from a permitted process (see, column 12, lines 44-50 of '112). Thus, the '112 system is for use by a single regulated entity or a chemical facility, and is directed to individualized management of data by a regulated entity.

The '112 system is about the "regulated" entity while the present invention is about the "regulator" that regulates the regulated entity. In particular, the present invention provides a database structure for use "by a regulating entity" or regulatory agency for managing "... multiple regulated entities" (see, claims 1, 33, 43, 44, 46, 47, 49, 51, 52, 56-60, 61-63, 65, 67-72 of the present application) allowing comprehensive management of information of the regulated entities to provide regulatory agencies with a centralized system to perform regulatory functions, such as issue permits and licenses, determine compliance, and take enforcement actions against violators. This is unlike the '112 system directed to use by a single regulated facility pertaining to individualized "on-site" management of a single regulated site (see, column 8, lines 50-67 of '112). The present invention solves the problems presented by individualized management of regulated entities, such as fragmented, uncoordinated, maintenance of data, by consolidating previously separate program functions into a single set of data management tools.

Further, the '112 system provides linking of six groupings pertaining to the regulated facility by utilizing a relational database schema or design that selectively integrates two or more of the six functional groupings to allow sharing of information on hazardous substances for in-house and regulatory compliance-related functions (see, column 9, lines 9-15, and FIG. 1 of '112). The exchange of information provided by the '112 system is limited to exchange or sharing of information between the six functional grouping (see, column 14, lines 58-65 of '112)

within one site for the purposes managing different aspects of the facility functions defined by the six groupings (see, column 11, lines 9-20 of '112). Thus, the '112 system does not provide sharing of information across multiple programs.

The system of the present invention identifies "subject items of the regulated entities.... where the subject items include objects and activities subject to regulatory requirements comprising multiple media" (see, claims 1, 33, 43, 44, 46, 47, 49, 51, 67-72, and FIG. 3 and corresponding text of the present application). For example, air emission, wastewater, and hazardous waste subject items relating to a paint pigment production process can be grouped into a single subject item that may be one of several industrial processes at a regulated entity (see, page 21, lines 17-25, and FIG.3 of the present application). This allows users of the system to share information regarding activities or equipments subject to a regulatory requirement, and provides program consistency in policies and work processes. This is not taught or suggested by the '112 system.

Accordingly, because the '112 system does not teach or suggest a database structure that identifies and manages "multiple regulated entities" where "subject items" are identified for cross-program sharing of information relating to a regulated item or activity, the '112 system does not anticipate the present application. At least for the above-discussed reasons, the dependent claims depending from independent claims 1, 33, 43, 44, 46, 47, 49, 51, 52, 56-60, 61-63, 65, 67-72 are patentable over '112.

REJECTION UNDER 35 U.S.C. §103(a):

Claims 33-38 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,726,884 ('884). The rejection is traversed and reconsideration is respectfully requested.

'884 discusses an integrated hazardous substance tracking and compliance system having eight functional groupings and database design where the functional groupings are integrated to allow the groupings to share and exchange information.

The Examiner compares the joint-usage database of the present invention with the functional groupings allowing sharing of information on hazardous substances for in-house and regulatory compliance-related functions. A "joint usage database" according to the present application allows exchange and sharing of commonly applicable information by multiple distinct regulated areas. This is achieved by "displaying the data stored in the joint-usage database to all regulating entity personnel having security clearance, regardless of the assignments for

which the personnel are responsible" (see, claim 33 and FIG. 3 of the present application). Similar to the '112 system, the '884 system is limited to sharing of information of a chemical facility by allowing information to be shared among the functional groupings (see, column 9, lines 52-67 of '884).

The Examiner acknowledges that '884 does not disclose the security clearance, however, the Examiner asserts that the '884 system provides a user log-on identification. According to the '844 system, an authorized user can print a chemical profile appended to a Materials Safety Data Statements/Sheets upon logging on to the system of the chemical facility (see, column 30, lines 5-10 of '884). The "security clearance" in the present application pertains to authorized accesses to the system including by users of other regulated interests. This is unlike the log-on process in '884 that is limited to accesses to authorized users within the chemical facility.

The burden of establishing a *prima facie* case of obviousness based upon the prior art lies with the Examiner. In re Fritch, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992). According to In re Fritch, the Examiner "... can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." Further, "rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention." In re Rouffet, 149 F.3d 1350, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). The Applicants respectfully assert that a *prima facie* case of obviousness has not been met by the Examiner because the cited references do not teach or suggest a database structure system for managing "multiple entities" to provide a centralized information management system which allows a display of "data stored in [the] joint-usage database to all regulating entity personnel".

For at least the above-discussed reasons, rejection of all outstanding claims is traversed.

NEW CLAIM:

New claim 90 has been added to clarify that the present invention comprises primary and secondary databases where subject items are "applicably linked to the multiple regulated entities for centralized use by the multiple regulated entities and the regulatory agency". This allows centralization of commonly used information among multiple regulated entities to reduce the time and effort for a regulatory agency to issue permits and license, determine compliance,

and take enforcement action against violators (govern or direct according to rule). Accordingly, because none of the cited references enable centralization of information, claim 90 is allowable over the cited references.

CONCLUSION:

In accordance with the foregoing, claim 90 has been added. Claims 1, 2, 4-7, 9-15, 33-38, and 43-90 are pending and under consideration.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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